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10/826,869

04/16/2004

Ricardo Alexander Gomez

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08/28/2009

MCCORMICK, PAULDING & HUBER LLP
CITY PLACE II
185 ASYLUM STREET
HARTFORD, CT 06103

EXAMINER

KASZTEJNA, MATTHEW JOHN

ART UNIT

PAPER NUMBER

3739

MAIL DATE

DELIVERY MODE

08/28/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|---|---|--|
| Office Action Summary | Application No. 10/826,869 | Applicant(s) GOMEZ, RICARDO ALEXANDER | |
| | Examiner MATTHEW J. KASZTEJNA | Art Unit 3739 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice of Prosecution Reopening Following BPAI Decision

With respect to 37 CFR 1.198 and MPEP 1214.04, the Examiner has specific knowledge of the existence of particular reference(s) which indicate nonpatentability of the appealed claims; the particular reference(s) were disclosed by Examiner in an IDS filed 3/29/06 and considered on the merits 10/26/06; and TC3700 director, Donald T. Hajec, has approved of reopening prosecution by signing below. The following new ground(s) of rejection is/are set forth below.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7, 10-15 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication 2002/0022762 to Beane et al.

In regards to claim 1, Beane et al disclose a sterile apparatus to protect endoscopes comprising: an impact resistant housing 110 having an outer surface defining an opening 140, an interior of the housing defining a canal 114 having a first end 122 communicating with the opening and a second end 124 terminating (canal terminates via distal end 124 attached to bottle 118) within the housing for receiving a distal lens 14 of an endoscope 10 (see Figs. 2a-c); a defogging material 116/118 disposed adjacent to the second end of the canal for defogging a distal lens of an

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endoscope when inserted within the canal (see paragraph 0056). In the embodiment shown in Figures 2a-f, Beane et al. are silent with respect to a self-sealing mechanism disposed within the canal, the self-sealing mechanism being configured to allow for an endoscope to enter the canal and make contact with the defogging material and to prevent the defogging material from spilling out of the canal. However, as seen in Figs 6a-b, Beane et al. teach of an embodiment wherein a proximal region 612 includes a *distal seal 620* and a *proximal seal 622*. Distal seal 620 has a generally conical shape, and is oriented to remove fluid from shaft 12 of laparoscope 10 as laparoscope 10 is moved in the direction of arrow G. Proximal seal 622 has a generally circular shape, and acts to remove fluid and debris from shaft 12 as it is moved in the direction of either arrow F or arrow G. Proximal seal 622 can be, e.g., an O-ring. Seals 620 and 622 can be made from, e.g., silicone or various thermal-plastic rubbers (see paragraphs 0089-0090). The seals would also effectively remove any excess cleaning liquid deposited on the lens from sponge 116, upon removal of the endoscope from canal 114. Thus, Beane et al. demonstrate that one skilled in the art at the time the invention was made, would have been motivated to position a self-sealing mechanism(s) at the entrance end of the canal and/or within the canal in the disclosed first embodiment to effectively remove any fluid or debris from the distal lens 14 of the endoscope as it is inserted into the canal 114.

In regards to claims 2 and 4, Beane et al disclose a sterile apparatus to protect endoscopes, wherein the canal is shaped for receiving a plurality of types of endoscopes (see paragraph 002). Beane et al. teach that the dimensions of different

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components in device 110 can be altered to accommodate different types of optical surgical instruments. For example, opening 140, bore 142, and tube 114 need not be cylindrical. The dimensions can also be adjusted to accommodate optical surgical instruments other than those used in minimally invasive procedures (see paragraph 0062).

In regards to claim 3, Beane et al disclose a sterile apparatus to protect endoscopes, wherein the apparatus is made of disposable material as it is well-known that all materials regardless of composition are capable of being disposed.

In regards to claim 5, Beane et al disclose a sterile apparatus to protect endoscopes, wherein the apparatus is configured to protect endoscopes during intermittent use (see paragraph 0016).

In regards to claim 6, Beane et al disclose a sterile apparatus to protect endoscopes, wherein the apparatus is inherently configured to protect endoscopes during transportation (see Fig. 2a).

In regards to claim 7, Beane et al disclose a sterile apparatus to protect endoscopes, wherein the interior of the housing includes: a storage sheath 114 defining the canal, the outer surface of the housing and the storage sheath defining a cavity therebetween; and an impact absorbing material 120 substantially filling the cavity (see Figs. 2a-c and paragraph 0059).

In regards to claim 10, Beane et al disclose a sterile apparatus to protect endoscopes, wherein the impact absorbing material is a liquid (see paragraphs 0057-0058).

In regards to claim 11, Beane et al disclose a sterile apparatus to protect endoscopes, wherein the impact absorbing material is a gas (see paragraphs 0057-0058 and 0060). As broadly, as claimed, the air environment within the housing may be interpreted as an impact absorbing material. Furthermore, the heating pad includes a chemical mixture which when activated produces gases.

In regards to claims 12-15, Beane et al disclose a sterile apparatus to protect endoscopes, further comprising an anchor 162 and a cord 164 attached to the housing and the anchor, to be used for a means for removable affixing the housing to a surface (see Figs. 2d-e and paragraph 0066).

In regards to claim 42, Beane et al disclose a sterile apparatus to protect endoscopes, further comprising a reservoir 118 for communicating with the second end of the canal for accommodating the defogging material (see Fig. 2a and paragraphs 0012 and 0053)

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication 2002/0022762 to Beane et al. in view of Dohm et al. (U.S. Patent No. 5,720,391).

In regard to claim 8, Beane et al. disclose a sterile apparatus to protect endoscopes but are silent with respect to wherein the impact absorbing material is Styrofoam. However, Dohm et al. teach a similar transportation case for a medical instrument having a spacer 212 made of shock absorbing material, such as a Styrofoam material (see col. 5, lines 64-66). Dohm et al. thus demonstrate that the use of Styrofoam materials for cushioning a medical device during transport is well known in

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the art. Accordingly, it would have been obvious for one of ordinary skill in the art at the time the invention was made to utilize Styrofoam in the apparatus of Beane et al. as an alternate means for cushioning the endoscope.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication 2002/0022762 to Beane et al. in view of Lantz (U.S. Patent No. 6,910,582).

In regard to claim 9, Beane et al. disclose a sterile apparatus to protect endoscopes but are silent with respect to wherein the impact absorbing material is a gel. However, Lantz teaches a similar transportation case having a gel pack 40 for cushioning (see col. 5, lines 55-65). Lantz thus demonstrates that the use of gel materials for cushioning is well known in the art. Accordingly, it would have been obvious for one of ordinary skill in the art at the time the invention was made to utilize a gel in the apparatus of Beane et al. as an alternate means for cushioning the endoscope.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW J. KASZTEJNA whose telephone number is (571)272-6086. The examiner can normally be reached on Mon-Fri, 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Matthew J Kasztejna/
Examiner, Art Unit 3739

/Linda C Dvorak/
Supervisory Patent Examiner, Art
Unit 3739

8/12/09

/DONALD T HAJEC/

Director, Technology Center 3700